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Martin D. Moynihan  
PRTSI, Inc.  
P. O. Box 16446  
Arlington, VA 22215

EXAMINER

POLTORAK, PIOTR

ART UNIT PAPER NUMBER

2134

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/990,875

Applicant(s)

KATZ ET AL.

Examiner

Peter Poltorak

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38, 40-75 and 77-79 is/are pending in the application.
- 4a) Of the above claim(s) 39 and 76 are canceled and claims 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38, 40-42, 46-75 and 77-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Amendment, and remarks therein, received on 12/01/05 have been entered and carefully considered.
2. The Amendment introduces new limitations into the originally sole independent claims 1 and 46. The newly introduced limitations have required a new search and consideration of the pending claims. The new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

***Response to Amendment***

4. Applicant's arguments have been carefully considered.
5. As per claims 1-3, 10-15, 17, 25-27, 29, 33, 36, 40-42, 47-48, 56-60, 64-66, 68, 71, 73 and 77-78 applicant provides arguments allegedly separating *Boyle et al.*'s system from applicant's invention.
6. The current Office Action employs newly discovered prior art (resulted from the search necessitated by applicant's amendment) and as a result the applicant's arguments are void.
7. The corrections to the drawings and the specification have been accepted and the corresponding rejections are withdrawn.

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8. In an attempt to overcome the 112 first paragraph rejection directed towards claims 42 and 79 applicant points to the specification that contains similar language. The examiner points out that the lack of the similar language was not contested but rather the fact that the claimed invention was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular it is not clear how the approved activity request could be an output to a router involving applying a change to a routing table on the router. These two activities: approving request and changes to a routing table don't seem to have much in common and applicant does not disclose the details that could clarify the relationship between these two (or how the request approval results in routing table changes). On pg. 23 (*the "Remarks"*) applicant takes the liberty to interpret the limitation, and recites: "causing, involving or/and resulting" phrases to clarify the language. However, these particular statements are not described in the specification in such a way that one of ordinary skill in the art at the time of applicant's invention would understand "the approved activity request being an output to a router, involving applying a change to a routing table on the router" without undue experimentation.
9. Applicant arguments directed towards the 112 second paragraph rejection have been carefully considered. The arguments regarding abbreviations have been found persuasive and the rejection has been withdrawn. However, the rejection based on the use of trademark or trade names remains. Even if the trademark is supposed to be interpreted as a standard, applicant should clearly specify the particular version

of the standard (since the specification of different versions of a particular standard may substantially vary from each other) or clarify interpretation of the particular standard so that the metes and bounds are clearly defined.

10. Claims 1-38, 40-42, 46-75 and 77-79 have been examined.

***Claim Rejections - 35 USC § 112***

11. Claims 42 and 79 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

12. Claims 42 and 79 refer to an indication that the activity request is approved and recite that the approved activity request is output to a router, involving applying a change to a routing table on the router. However, the specification does not teach how communication of the authentication is achieved by changing a routing table. For details refer to paragraph 8, above.

13. Claims 1-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

14. Claims 2, 9, 31, 36, 47, 54, 70 and 73 remain rejected due to the use of trademarks in the claim language.

15. The term “operatively connected” in claim 1 is not understood. Similarly the recitations: “associator operative with said communicator, and operative through” and “an authentication communicator operative with said associator” are not understood.
16. It is not clear whether applicant uses the terms “operative” or “operatively” to indicate that the particular device “operates”, that is operable, or whether that the device works in conjunction with another device. In the particular example it is not clear whether the term “operatively connected” should be interpreted as “connected” wherein the connection works (in contrast to an inactive connection), whether it requires that “operatively connected” devices communicate with each other or whether there is some other interpretation. Similarly, it is not clear whether “an authentication communicator operative with said associator” means that each the communicator and the associator are able to operate, whether the communicator works (or is able to work) in conjunction with the associator, or whether there is some other intended interpretation of the language.
17. Also, in claim 46 it is not clear whether “indicating that said activity request is approved, by an authentication communicator operative with said associator” means that the request is approved by an authentication communicator, whether the authentication communicator indicates that the activity request is approved, or whether some other meaning is intended.
18. Claim 24 recites: “wherein said communicator provides an identifier with said reply for use via said non-authenticated device”. The phrase: “said reply for use via non-

authenticated device” is not understood. It is not clear whether the language of claim 24 should be interpreted as though the communicator provides an identifier that is then used by a non-authenticated device or whether some another meaning was intended.

19. Similarly ambiguity is observed in claim 63: “a password is provided in said reply, for use via said non-authenticated device.

20. Both of these claims comprise the limitation of the “intended use” (*for*) that is claimed in such a way that the claims are unclear. Only the limitation preceding the intended use is treated on its merits.

21. As discussed above claims 42 and 79 remain rejected as being indefinite.

22. Claims 3-8, 10-23, 25-30, 32-35, 37-38, 40-41, 48-53, 55-62, 64-69, 71-72, 74-75 and 77-79 are rejected by virtue of their dependence.

### ***Claim Rejections - 35 USC § 102***

23. Claims 1-2, 10-16, 20-22, 25-29, 33-36, 38 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by *Glikman* (U.S. Pub. No. 20010037254).

24. As per claim 1 the examiner points out that the claim language contains a recitation with respect to the manner in which a claimed apparatus is intended to be employed (“a communicator ... for providing authentication”, “an associator ... for associating said authentication...”, “an authentication communicator ... for indicating ...”, etc.), which “does not differentiate the claimed apparatus from a prior art apparatus if the

prior art apparatus teaches all the structural limitations of the claim. Ex parte

Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

25. Glikman teaches a communicator (*gateway*) for communicating, via an authenticatable link (*GSM [43]*) with an authenticatable mobile device (*Fig. 5*), an associator (*processing device*) operatively connected to the communicator, and operatively connected through an insecure or non-authenticated link to a non-authenticated device (*customer device, Fig. 1*) and an authentication communicator (*Vendor Device*), operatively connected to the associator (*connected via network 200, Fig. 1*).

26. As per claims 2, 10-16, 20-21, 26-29, 33-36, Glikman discloses that the authenticatable mobile device is a mobile telephone [*37*] using SIM card [*44-45*], teaches that the communicating comprises an electronic messaging [*65 and 44*] using WAP, GMS or SMS [*44*], teaches TCP/IP link (*Internet Network 200 [39]*), the communicator operable to obtain identification data and a telephone number for communicating with the authenticatable mobile device [*49 and 52*], the non-authenticated devices being any one of a group comprising a credit card, a smart card, an infra-red device, a Bluetooth, a mobile computer, a fixed computer, and a network of computers [*40*], teaches that the non-authenticated device starts the communicating by sending activity request [*48*], teaches that the authenticatable mobile device is associated with a payment account and that the apparatus comprises functionality to charge the activity request to the payment account and



that the activity request is a point of sale activity and that activity request is an Internet browsing activity [14-15, 46 and 48].

27. As per claims 22, 25, 38 and 41 applicant is reminded that the use of such a language as "comprise functionality" or "is operable" is not a positive recitation. The examiner acknowledges that use of such a language only requires that a method has the capability to perform a particular function - not that it actually performs them. Accordingly, the examiner has given nominal consideration to such limitations. Glikman teaches that the authentication communicator is a computer that is connected with the non-authentication device and the authenticatable mobile device by a computer network, thus it comprises functionality to receive an initializing communication from either one of the authenticatable mobile device and the non-authenticated device, and functionality to send a reply to the initial message it is operable to communicate the activity request to an external gateway associated with the non-authentication device, to a server associated with the activity request and to communicate the approved activity request to a router [48-49, 52 etc.]. Also, personal computers comprise (and frequently implement e.g. Windows NT workstations) logging in functionality. Computers are capable to use an automatic voice for communicating with other devices (e.g. providing the automatic voice to other devices, a network telephone system, for example). It is accomplished by various means: adding voice recognition software, storing data that comprise recorded voice etc.

***Claim Rejections - 35 USC § 103***

28. Claims 3-9, 17-19, 23-24, 30-32, 37, 40, 46-61, 62-63, 65-75 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Glikman* (U.S. Pub. No. 20010037254) in view of *Willins et al.* (U.S. Pub. No. 20030021250).

29. As per claim 46 *Glikman* teaches the communicator, the authenticatable mobile device, the non-authenticated device, and the authentication communicator as discussed above.

30. *Glikman* does not explicitly teach the communicator providing authentication of the authenticatable mobile device.

31. *Willins et al.* teach a communicator providing authentication of the authenticatable mobile device [17].

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use a communicator to authenticate the authenticatable mobile device as taught by *Willins et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to assure that the mobile device is authorized to conduct communication with the network as described in *Willins et al.* [17].

32. As per claims 23 and 62-63 it is implicit that the communication between the authenticatable mobile device and the communicator starts with powering up the authenticatable mobile device and in mutual authentication (as disclosed by *Willins et al.*) both communicating devices are authenticated. Thus, in addition to authenticating the authenticatable mobile device the communicator replies with a password to the authenticatable mobile device in order to be authenticated.

33. As per claim 24 Glikman does not explicitly teach that the communicator provides an identifier with the reply.

34. Official Notice is taken that it is old and well-known practice to provide an identifier with a reply (e.g. *TCP/IP: ack number, device ID such as an address etc.*). One of ordinary skill in the art at the time of applicant's invention would have been motivated to configure the communicator so that an identifier is included with the reply so that the reply could be associated with a request in response to which the reply is sent and in case of authentication a received password could be associated with the appropriate id.

35. The examiner also points out that Glikman suggests utilizing in his invention GSM [43] that (as also pointed out by applicant in the specification on pg. 11 lines 20-21) provides authentication of GSM devices.

36. As per associating the authentication with an activity request, Glikman discloses an activity request that is followed by a response from the authenticatable mobile device (*after the customer selects the commodities that the customer desires to purchase, the vendor device transfer the customer request to the processing device that sends the authorization request to the mobile device [48-49]*).

37. Also, Glikman discloses that the associator associates the activity request with the authentication (*bills the account associated with the authenticated authenticatable mobile device [18]. The charge occurs after the purchase amount is confirmed [40] and as previously discussed the conformation is the reply to the authorization request received by the authenticatable mobile device*).

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38. In [40] and Fig. 13 object 910 Glikman clearly discloses indicating that the activity request is approved.

39. As per claim 62 the request to the authenticatable mobile device must go through the communicator as well as the reply from the authenticatable mobile device (see Fig. 6).

40. Claims 47, 55-61, 65-68, 71 and 73 are substantially equivalent to claims 2, 10-15, 20, 26-29, 33 and 36; therefore claims 47, 55-61, 65-68, 71 and 73 are similarly rejected.

41. As per claims 3-9 and 48-54 Glikman does not teach that authenticatable mobile device is a CDMA, IS-136, PDC, EDGE, WCDMA, GPRS, or Iridium device and that the authenticatable link is a CDMA, IS-136, PDC, EDGE, WCDMA, GPRS, or Iridium link. However, the use of various network protocols to connect authenticatable and non-authenticatable devices is old and well-known practice (*as also acknowledged by applicant, "Remarks" last § on pg. 24*), and using WAP, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium links with associated devices would have been obvious to one of ordinary skill in the art at the time of applicant's invention. One of ordinary skill in the art would have been motivated to use various network protocols such as WAP, CDMA, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium links with associated devices in order to extend the invention to various types of technologies. Utilizing these protocols are obvious variations that are well known in the art. One would have been motivated to use them especially in light of the benefits of these technologies as evidenced by their commercial success.

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42. Similarly, as per claims 17-19 Glikman does not explicitly teach that the electronic messaging comprises email, EMS and MMS. However, it is old and well-known practice to use various electronic messaging protocols and using email, EMS and MMS would have been obvious to one of ordinary skill in the art at the time of applicant's invention. One of ordinary skill in the art would have been motivated to use various types of electronic messaging protocols such as EMS and MMS in order not to allow devices with multiple electronic messaging protocols (*such as EMS and MMS*) to utilize Glikman's invention. Utilizing these protocols are obvious variations that are well known in the art. One would have been motivated to use them especially in light of the benefits of these technologies as evidenced by their commercial success.

43. As per claims 30-32 and 69-70 Glikman does not explicitly teach connecting to the network via Bluetooth, infra-red or WLAN access points. Using various technologies to connect to non-authenticable devices is old and well-known practice. One of ordinary skill in the art would have been motivated to use various technologies such as Bluetooth, infra-red or WLAN in order to connect to authenticable in order to extend Glikman's invention to various technologies. Utilizing these protocols are obvious variations that are well known in the art. One would have been motivated to use them especially in light of the benefits of these technologies as evidenced by their commercial success.

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44. As per claims 37 and 74 Glikman does not explicitly teach that the apparatus further comprises a timer for timing and timeout (after a predetermined time limit) of the authentication.

Official Notice is taken that it is old and well-known practice to time and time out authentication after a predetermined time limit (*e.g. time stamp, Pfleeger, 168-169 and 414*). One of ordinary skill in art at the time of applicant's invention would have been motivated to employ timing and to timeout of the authentication in order to increase security. The timing would require a timer.

45. As per claim 72 Glikman teaches obtaining from the non-authenticated device the authenticatable mobile device identification that is used to obtain a telephone number for communicating with the authenticatable mobile device. Glikman stops short of disclosing that the telephone number is obtained from the non-authenticated device.

However, obtaining the telephone number from the non-authenticated device would have been an obvious modification given benefit of the usability: it is much easier to recall a telephone number than a telephone identification and since the subscriber of the telephone must verify the transaction there is no gain in security by introducing complexity.

46. As per claim 75 Glikman teaches that the non-authenticated device is a personal computer accessing web sites [40] but stops short of disclosing that the non-authenticated device comprises functionality for logging in.

Official Notice is taken that it is old and well-known practice to provide the functionality for logging in the non-authenticated device (*e.g. Windows NT clients*) given benefit of restricting the use of the device only to authorized users.

47. As per claim 78 Glikman clearly discloses that the activity request is handled by a server (*in this case the authentication communicator*) that results in requesting a reply authorizing the activity request (*after the customer selects the commodities that the customer desires to purchase, the vendor device transfers the customer request to the processing device that sends the authorization request to the mobile device [48-49]*).

Official Notice is taken that it is old and well-known practice to output to a server indication of approval of activity requests (*e.g. approve credit card charges*) and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the server (*vendor device*) associated with the activity request with the output that indicates the approved activity request. One of ordinary skill in the art would have been motivated to perform such a modification in order to notify the server that the transaction has been approved (and charges accepted) so that the transaction could be completed (the commodities sent to a customer).

48. As per claims 40 and 77 Gilkam does not explicitly teach that the approved activity request is outputted to an external gateway associated with the non-authenticated device. However, the limitation is implicit since networks, especially Internet, involve multiple external gateways (*e.g. routers, repeaters, switches, hubs etc.*) to connect network communicating devices thus the approved activity request to be

communicated from one to another device would need to be outputted to an external gateway. As per claim 78 the external gateways read on servers since they serve clients (e.g. forward/route received packets).

49. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Glikman* (U.S. Pub. No. 20010037254) in view of *Willins et al.* (U.S. Pub. No. 20030021250) and further in view of *Nemoto* (U.S. Pub. No. 20010010714).

50. *Glikman* in view of *Willins et al.* teach a method comprising communicating as discussed above.

51. *Glikman* in view of *Willins et al.* do not explicitly teach that the method comprises using an automatic voice.

52. *Nemoto* teaches using an automatic voice (*Nemoto*, [2]).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate an automatic voice as taught by *Nemoto* into *Glikman* in view of *Willins et al.*'s invention given benefit of the reduced number of human operators needed.

### ***Conclusion***

Applicant's invention is directed towards authorization of a transaction initiated by the non-authenticatable device with the authenticatable device. Although, *Glikman* discloses a similar invention, *Glikman* does not disclose the unique feature disclosed in applicant's specification: providing a password to the authenticatable device that is then entered to the non-authenticatable device (the specification, pg. 15 lines 9-22).



In considering any amendments, applicant may want to pay particular attention to the art listed below. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Vazvan, (*International Pub. WO 97/45814*),  
Downning (*UK Patent No. 2379525*),  
Eun (*U.S. Pub. No. 20030005136*),  
Branigan et al. (*U.S. Pub. No. 20020090089*),  
Audebert et al. (*U.S. Pub. 20020194499*),  
Rose ("*Authentication and Security in Mobile Phones*"),  
Guthery et al. "GSM SIMs as Web Servers".

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Signature

2/8/06  
Date

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100